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LEIL & WEINKAUF  
1101 CONNECTICUT AVENUE NW  
WASHINGTON DC 20036

EXAMINER

PRATT

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/487,000

Applicant(s)

Broeckel et al.

Examiner

Pratt, Helen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 19, 21 is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 21, drawn to a preservative and process of using and making, classified in class 426, subclass 321.
- II. Claim 20, drawn to a method of preserving leather, classified in class 252, subclass 8.57.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination does not require treating leather. The subcombination has separate utility such as a preservative for foods and silage. Inventions I and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Keil on 7-13-01 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-19, 21. Affirmation of this election must be made by applicant in replying to this Office action. Claim 20 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 is indefinite in the use of the term "animal food or silage". Silage is generally used as animal food, therefore the terms are redundant and also one term encompasses the other.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Ooijen (GB 0608975 A) or Gonthier et al. or Kotani et al.

The claims are rejected for the reasons of record cited in the last office action. Claim 16 further requires that the impregnated salts are added to human or animal food and claim 21 that the salts are placed on or into an item to be treated. Van Ooijen discloses that it is known that organic acids are added to silage and mixed with the silage (page 2, lines 2-10). Therefore, it would have been obvious to use the claimed composition in treating silage.

Claim 17 further requires the use of formulation auxiliaries. Kotani discloses the use of glycerin in such a process. Therefore, it would have been obvious to add a formulation aid as shown by Kotani et al. and also, to add it in the process of Ooijen or Gonthier et al. for its function of restraining offensive odor and of scattering the powder of the salts (abstract).

Claim 18 further requires the use of particular organic salts and their acids as does claim 19. Van Ooijen discloses the use of propionic acid and an aliphatic carboxylic acid (abstract). Gonthier et al. disclose the use of some of the claimed acids and salts (col. 1, lines 45-55) as does Kotani et al. (abstract). Applicants are using particular salts and have excluded the acetic acid salt as in Van Ooijen. There is

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no reason to drop this reference absence a showing of unexpected results using the claimed salts. Therefore, it would have been obvious to use the acids and salts as shown by the references.

### ARGUMENTS

Applicant's arguments filed 6-5-01 have been fully considered but they are not persuasive.

Applicants argue that their carboxylate salts are not limited to those of the reference nor have their pKa values. However, the claims do not exclude the salts and acids of the references but include them except for the acetic acid. It is not seen that the reference teaches away from the claimed invention when it includes the teachings of the reference.

Applicants argue that the mechanism of action is dependent on the relative pKa values in the reference to van Ooijen et al. However, applicants' claims are also to compositions and methods of using the composition and process of making which do not exclude the instant reference.

As to the amount of carboxylic acid used in the compound, the reference discloses ranges in the claimed amount and more. The reference discloses that the amount of acid used is limited only by the physical ability of the two to be admixed or impregnated (col. 3, lines 10-15). Nothing is seen at this time showing unexpected results in using the claimed amounts.

It is not seen that having different objectives is a sufficient reason for allowing the claims based on amounts. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a preservative product, properties such as

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acidifying and preserving are important. It appears that the precise ingredients as well as their proportions affect the acidifying characteristic and preservation characteristics of the product, and thus are result effective variables which one of ordinary skill in the art would routinely optimize.

No data is seen comparing the improved storage properties particularly as van Ooijen encompasses these.

Applicants argue the limitations of the process of Kotani in regard to composition and method of using. The method of making is not given weight in composition claims. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796.

As to the process, claim 1 says that "at least one salt is used as in the reference . The further limitations as to the process of the reference is not excluded by the reference because the claims are to broadly carboxylic salts and acids. The information as to the term impregnation should be in the claims if the claims are to be read in that light. The claims do not exclude the use of ethanol.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Helen Pratt at telephone number 703-308-1978.

Hp 7-13-01

  
HELEN PRATT  
PRIMARY EXAMINER